REMARKS

The present amendment is submitted in response to the Office Action dated November 24, 2004, which set a three-month period for response. Filed herewith is a Request for a Three-month Extension of Time, making this amendment due by May 24, 2005.

Claims 1-14 are pending in this application.

In the Office Action, claims 1-14 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. Claims 1-14 also were rejected under 35 U.S.C. 112, second paragraph, as being indefinite. Claims 1-9, 12, and 13 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent NO. 4,739,206 to Sieber in view of the reference to Kalpakjian. Claims 1-13 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent NO. 6,450,782 to Sakamoto in view of Kalpakjian. Claim 14 stands rejected under 35 U.S.C. 103(a) as being unpatentable over either one of Sieber and Sakamoto in view of Kalpakjian, further in view of U.S. Patent No. 3,066,449 to Cramer.

Turning first to the rejection under Section 112, first paragraph, the Applicants respectfully disagree with the basis for this rejection. A practitioner skilled in the relevant art knows the temperature range of an electric motor, so that it is not necessary to go into detail within the description on this point. In addition, every motor carries a type label that contains characteristic details about the motor, such as maximum speed, current, and temperature. Therefore,

it would not represent a problem for the skilled practitioner to first determine the kind of motor to be used and then to prepare the apparatus of the present invention. This process cannot be seen as "undue experimentation", since there are clearly defined boundary conditions available to the practitioner.

In addition, the behavior of the thermal conductivity relative to the operating temperature can be neglected, since the area of operation of such a motor in the range in which the thermal conductivity is claimed is relatively small. "Undue experimentation" would require no boundary conditions and absolutely no idea as to the temperature range. This is not the case with the present invention.

With regard to the rejection under Section 112, second paragraph, claim 1 has been amended to delete the term "approximately".

Looking now at the substantive rejections under Section 103, the cited patent to Sieber shows the state of the art that was already considered in the present application. Sieber discloses a base assembly for a dynamo electric machine. Thermal attributes are irrelevant and the attributes of the present invention are not disclosed in this reference.

The cited pages of the Kalpakjian reference (pp. 990-1004, 139, and 645-649) discuss the treatment of several surfaces, for example, for hardening them in connection with cutting apparatuses for stainless steel (see page 649). In this reference, several methods are discussed, such as how the surface of a tool or an apparatus can be protected against abrasion. An apparatus for optimizing the

thermal conductivity of a base assembly for a dynamo electric machine is not disclosed in Kalpakjian, however.

One skilled in the art, beginning with the Sieber reference, would find no suggestion or motivation to combine Sieber with Kalpakjian or vice versa. Even if the two documents were combined, the fact that Kalpakjian mentions several materials and their thermal features is not sufficient to assume that is would be obvious for one skilled in the art to use the metallic coating as defined in claim 1 of the present application, that is, to optimize the power output of a motor. If someone intends to optimize the power output of a motor, he/she would study documents that discuss exactly this problem and not documents that described hardened surfaces or mechanical base assemblies.

Indeed, the combination of these references amounts to impermissible hindsight, because only someone who already had knowledge of the invention might be motivated to combine the documents. The combination of elements from non-analogous sources in a manner that reconstructs the applicant's invention only with the benefit of hindsight is insufficient to present a *prima facie* case of obviousness. ***In re Oetiker***, 24 USPQ 2d 1443, 1446 (Fed. Cir. 1992).

The present invention improves the transport of lost heat of a motor as effectively as possible via a base assembly. This has the advantage that the power output of a motor can be optimized in such a way that the size of the motor remains the same, while the power output is increased. Such a solution cannot be derived from either of the above references, whether viewed alone or in combination.

With regard to the combination of the Sakamoto and Kalpakjian references, the same argument as presented above would apply, since only the mechanical design of the base member in Sakamoto is different from Sieber's.

It is respectfully submitted that since the prior art does not suggest the desirability of the claimed invention, such art cannot establish a prima facie case of obviousness as clearly set forth in MPEP section 2143.01. The Applicants therefore respectfully submit that claim 1, along with its dependent claims 2-14, are patentable over the cited references.

In light of the foregoing amendments and arguments in support of patentability, the Applicants respectfully submit that this application stands in condition for allowance. Action to this end is courteously solicited.

Should the Examiner have any further comments or suggestions, the undersigned would very much welcome a telephone call in order to discuss appropriate claim language that will place the application into condition for allowance.

Respectfully submitted,

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